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EXAMINER

DANG, KHANH NMN

ART UNIT PAPER NUMBER

2111

10

DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/846,807

**Applicant(s)**

SELNA ET AL.

**Examiner**

Khanh Dang

**Art Unit**

2111

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2003.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 22-37 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 22-37 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

Claims 22-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 22 and 33, "first chassis" and "second chassis" lack antecedent basis.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 22-28, and 32-37 are rejected under 35 U.S.C. 102(e) as being anticipated by MacLeod et al.

At the outset, it is first noted that similar claims will be grouped together to avoid repetition in explanation.

As broadly drafted, these claims do not define any structure that differs from MacLeod et al. With regard to claims 22 and 26, MacLeod et al. discloses a computer system, comprising a primary chassis (housing of PC 60); a primary device (PC 60) having a bus for carrying electrical signals, wherein the primary device (PC60) is disposed in the primary chassis (housing of PC60); a secondary chassis (housing of peripheral device 50); and an external device (peripheral device 50) having a bus for carrying electrical signals, the primary chassis and the secondary chassis are positioned substantially adjacent to one another; wherein the external device (50) is disposed in the secondary chassis (housing of peripheral device 50) and the external device bus is directly electrically interconnected with the primary device bus so that the electrical signals carried on the primary device bus are transmitted to the external device bus and the electrical signals carried on the external device bus are transmitted to the primary device bus; and a bridge circuit board (included in 10) capable of directly electrically interconnecting the primary device bus and the external device bus. Note also that it is clearly inherent that the bridge circuit board (included in 10) must include detachable connectors for mating with the connectors of the PC and the external device, respectively, so that signals can be conveyed between the system bus of PC 60 and peripheral bus of external device (50). In addition, it is clear from at least Fig. 11 that the bridge circuit board (included in 10) comprises signal traces for providing signal interconnection between the system bus and the peripheral bus.

With regard to claim 23, it is clear that the primary chassis and secondary chassis are stacked one on top of the other.

With regard to claim 24, it is clearly inherent that computer (60), as in any conventional PC, must include a motherboard.

With regard to claim 25, it is clear from MacLeod et al. that peripheral device 60 is a device selected from the group consisting of a storage medium, a graphics processor, and a sound processor.

With regard to claim 27, In MacLeod et al., it is clear that the hub 10 is capable of receiving the signals from the primary device bus at a first transmission speed (from host to hub 10, for example) and is capable of repeating the signals over the external device bus at a second transmission speed (either USB, IEEE 1394, SCSI, PCI I/F, PCMCIA, or IRDA speed, for example), and wherein the hub 10 is capable of receiving the signals from the external device bus at a second transmission speed (either USB, IEEE 1394, SCSI, PCI I/F, PCMCIA, or IRDA speed, for example) and is capable of repeating the signals over the primary device bus at the first transmission speed (from hub to host, for example).

With regard to claim 28, in MacLeod et al., it is clear that host 10 is capable of translating electrical signals from a first signal protocol to a second signal protocol (either USB, IEEE 1394, SCSI, PCI I/F, PCMCIA, or IRDA protocol, for example).

With regard to claim 32, as in any PC housing, it is inherent that the housing of PC 60 includes cooling device such as heatsink or fans. It is also inherent that the video driver (card)/hard drive of external device 50, as to any conventional video card/external hard drive, is provided with either a passive heatsink or an active fan.

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With regard to claims 33-37, it is clear that one using the system of MacLeod et al. would have performed the same steps set forth in claims 33-37.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over MacLeod et al.

MacLeod et al., as explained above, discloses the claimed invention including the use of a bridge circuit. However, MacLeod et al. do not disclose that the bridge circuit is implemented on a single circuit chip. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a single chip to form the bridge circuit of MacLeod et al., since the Examiner takes Official Notice that it is well-known in the art that a circuit can be either implemented on a single chip or interconnected chips; and selecting one design over the other for a specific intended use or design specification only involves routine skill in the art. If the Applicants choose to challenge the Official Notice, supportive document(s) will be provided upon request.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over MacLeod et al.

MacLeod et al., as explained above, discloses the claimed invention including the use of a bridge circuit. However, MacLeod et al. do not disclose that the bridge circuit is implemented on a plurality of chips. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a plurality of chips to form the bridge circuit of MacLeod et al., since the Examiner takes Official Notice that it is well-known in the art that a circuit can be implemented either on a single chip or interconnected chips; and selecting one design over the other for a specific intended use or design specification only involves routine skill in the art. If the Applicants choose to challenge the Official Notice, supportive document(s) will be provided upon request.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over MacLeod et al.

MacLeod et al., as explained above, discloses the claimed invention except the use of a separate power supply for providing power to the external device. It would have been obvious to one of ordinary skill in the art at the time the invention was made to power the external device (50) of MacLeod et al. using a separate power supply (instead of using the power supply drawn from the bus), since the Examiner takes Official Notice that it is well-known in the art that an external device (USB device, for example) can be either self-powered or bus powered; and selecting one design over the

other for a specific intended use or design spec only involves routine skill in the art. If the Applicants choose to challenge the fact that it is well-known in the art that an external device (USB device, for example) can be either self-powered or bus powered, supportive document(s) will be provided upon request.

### ***Response to Arguments***

Applicants' arguments filed 12/19/2003 have been fully considered but they are not persuasive.

At the outset, Applicants are reminded that claims subject to examination will be given their broadest reasonable interpretation consistent with the specification. *In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997). In fact, the "examiner has the duty of police claim language by giving it the broadest reasonable interpretation." *Springs Window Fashions LP v. Novo Industries, L.P.*, 65 USPQ2d 1862, 1830, (Fed. Cir. 2003). Applicants are also reminded that claimed subject matter not the specification, is the measure of the invention. Disclosure contained in the specification cannot be read into the claims for the purpose of avoiding the prior art. *In re Sporck*, 55 CCPA 743, 386 F.2d, 155 USPQ 687 (1986).

With this in mind, the discussion will focus on how the terms and relationships thereof in the claims are met by the references. Response to any limitations that are not in the claims or any arguments that are irrelevant and/or do not relate to any specific claim language will not be warranted.



**The MacLeod et al. 102 Rejection:**

With regard to claims 22 and 33 (with their respective dependent claims stand or fall together), Applicants argued that in MacLeod et al., "there are not two chassis interconnected by a bridge circuit board." Contrary to Applicants' argument, the primary chassis of PC (60) and chassis of peripheral device (50), as clearly explained above, are interconnected by a bridge circuit board included in hub 10. See at least Figs. 2 and 3, and description thereof. Applicants further argued that MacLeod et al. do not disclose "the first chassis and the second chassis are positioned substantially adjacent to one another." Contrary to Applicants' argument, "adjacent" does not require absolute contact, but requires relatively close position. *Ex parte Hadsel*, 109 USPQ 509. In the instant case, it is clear that the first chassis and the second chassis of MacLeod et al. are positioned substantially adjacent to one another. Applicants additionally argued that the bridge circuit board of MacLeod et al. does not include connectors and signal traces. Contrary to Applicants' argument, it is clearly inherent that the bridge circuit board (included in 10) must include detachable connectors for mating with the connectors of the PC and the external device, respectively, so that signals can be conveyed between the system bus of PC 60 and peripheral bus of external device (50). In addition, it is clear from at least Fig. 11 that the bridge circuit board (included in 10) comprises signal traces for providing signal interconnection between the system bus and the peripheral bus.

**The MacLeod et al. 103 Rejection:**

Applicants do not separately argue against the 103 rejection set forth in the previous Office Action.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Khanh Dang at telephone number 703-308-0211.



Khanh Dang  
Primary Examiner